

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: § Attorney Docket No.
BOBBIE JOE BOWDEN § B-0106.01
§
Serial No.: 08/050,527 § Examining Atty.
§ To be assigned
Filed: April 19, 1993 §
§
For: AUTOMATIC DRILLING SYSTEM §

RECEIVED

MAY 20 1993

DECLARATION OF DONALD R. COMUZZI

COMMISSIONER OF PATENTS
AND TRADEMARKS
Washington, D.C. 20231

Attn: Licensing and Review

Sir:

I, DONALD R. COMUZZI, declare as follows:

I am a patent attorney registered to practice before the United States Patent and Trademark Office, Registration No. 22,852, and I represent Applicant, Bobbie Joe Bowden, in the above-referenced Application.

The subject matter of the above-referenced U.S. Patent Application is not now under a secrecy order nor has it been under a secrecy order at any time prior to the filing of the Canadian Patent Application. Furthermore, both the U.S. and Canadian Patent Applications are drawn to the subject matter of automatic drilling systems which is subject matter not typically considered sensitive subject matter for patent filing purposes. In my experience, patent applications drawn to this subject matter are not restricted due to national security and, normally, receive a foreign filing license granted on the filing receipt.

Applicant contacted me in late March of 1993 and requested that I prepare patent applications for filing both in the United States and Canada. Upon discussing the requested filings with Applicant, I ascertained that the subject matter sought to be patented had been publicly used in both the U.S. and Canada on or after April 20, 1992. Because both the U.S. and Canada have similar one year public use statutory bars, both the U.S. and

*Priority
Application*

Canadian Patent Applications had to be filed on or before April 19, 1993. Accordingly, at the time of undertaking the representation of Applicant, I had less than three weeks in which to prepare and file both patent applications in order to preserve Applicant's patent rights in the U.S. and Canada. Essentially, I had no alternative except to file the Canadian Patent Application contemporaneously with the U.S. Patent Application and then seek a retroactive foreign filing license under 35 USC §184 because of the limited time period within which to prepare and file both applications.

Applicant sought patent protection late within the public use statutory periods of both the U.S. and Canada due to his desire to determine the marketability of his automatic drilling system and his ignorance of the U.S. and Canadian Patent Laws. That is, Applicant did not wish to invest large sums of money in his system until he ascertained its commercial viability. Furthermore, although Applicant is a U.S. citizen and the subject matter of the U.S. and Canadian Patent Applications was conceived of and reduced to practice in this country, Applicant marketed his system in Canada because persons in that country provided the largest market and also showed the greatest commercial interest. In fact, Applicant was able to license his system to a Canadian corporation for the sum of \$17,000.00, conditioned upon Applicant's filing of a Canadian Patent Application. Unfortunately, Applicant's conclusion of his test marketing and his negotiation of the above-agreement did not transpire until nearly the end of the U.S. and Canadian public use statutory periods.

As previously stated, Applicant contacted me in late March and inquired into the filing of both U.S. and Canadian patent applications. After agreeing to represent Applicant, I prepared the requested U.S. application which was completed for filing and executed by Applicant on April 19, 1993. Additionally, I also had to file the Canadian Patent Application on the same date, which was accomplished by fax transmission to my Canadian Associate.

Based upon Applicant's agreement with the Canadian corporation

coupled with their promised payment of the initial \$17,000.00, Applicant's Canadian Patent Application was equally important to Applicant's U.S. Patent Application. Because both the U.S. and Canadian Patent Application had to be filed no later than April 19, 1993, I had no opportunity to obtain a prospective foreign filing license and, further, had no alternative except to file Applicant's Canadian Patent Application. If I had not contemporaneously filed the Canadian Patent Application, Applicant would have lost his Canadian Patent rights.

From the filing of the Canadian Patent Application on April 19, 1993 until the submission of this Declaration and required Petition, I researched the appropriate statutes and conferred by telephone, with Mr. Tubbesing, a Licensing and Review Examiner, to determine the proper procedure for obtaining a retroactive foreign filing license under 35 USC §184. . I further collected the above information concerning Applicant's decision to market his system in Canada before seeking patent protection and, also, his agreement with the Canadian corporation regarding their marketing of his automatic drilling system. After researching the appropriate statutes and accumulating the necessary information, I prepared the Petition accompanying this Declaration in accordance with 37 C.F.R. §§ 5.14 and 5.25 to request a retroactive foreign filing license under 35 USC §184. Furthermore, I have submitted that Petition and this Declaration within one month of the proscribed foreign filing in order to diligently seek a license to retroactively permit the filing of the Canadian Patent Application.

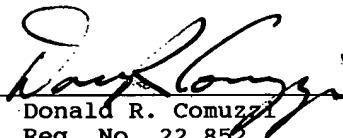
FURTHER DECLARANT SAYETH NOT.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and, further, that these statements are made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 USC §1001 and that such willful false statements may jeopardize the validity of the document or application or any patent issued thereon.

Respectfully submitted,

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DATE: May 19, 93

By: 

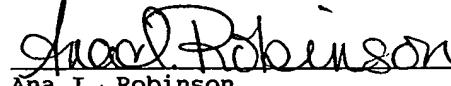
Donald R. Comuzzi
Reg. No. 22,852

ATTORNEY FOR APPLICANT

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail, Post Office to Addressee" service under 37 CFR 1.10 on the date indicated below and addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Express Mail No. RB901394582US Date 5-18-93


Ana I. Robinson